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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,583	03/02/2004	Marko Stankovic	StankovicM_P_1_04	3466
34442	7590	05/22/2006	EXAMINER	
PATRICIA M. COSTANZO			NGUYEN, TUAN N	
PATS PENDING			ART UNIT	PAPER NUMBER
P.O. BOX 101				3751
ELMA, NY 14059				

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/791,583	STANKOVIC, MARKO
	<b>Examiner</b>	<b>Art Unit</b>
	Tuan N. Nguyen	3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 February 2006.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/2/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Invention I, claims 1-15 and 20, in the reply filed on 2/20/06 is acknowledged. The traversal is on the ground(s) that the pocket clip cutting element unit of claim 16, which belong to Invention II, is also presented in a dependent claim 11 of Invention I and that the search for both invention are inclusive. This is found persuasive. Accordingly, the restriction is hereby withdrawn and claims 16-19 are no longer withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 11-13 recite the limitation "The pocket clip cutting element unit" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is unclear as to whether "The pocket clip cutting element unit" is referring to the "pocket clip unit" in line 3 of claim 1 or the "cutting element" in line 4 of claim 1.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11, 14-16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheldin '169.

In regard to claims 1 and 20, Cheldin '169 discloses a letter opener writing instrument device (see Fig. 8) comprising i) a writing instrument (16) having a case; ii) a pocket clip unit (element 24 is capable of being a pocket clip unit) affixed to the writing instrument, and iii) a cutting element (32) operatively attached to the device, the cutting element positioned between the writing instrument and the pocket clip unit providing for paper to be cut by the letter opener writing instrument.

In regard to claim 2, the device further comprises a stopper (where 20 is pointing) affixed to the writing instrument thereby limiting accessibility to the cutting element.

In regard to claims 3 and 4, the stopper could either be affixed to the pocket clip unit or the case (see col. 2, line 4 et seq.).

In regard to claim 5, the device further comprises a spacer (where 20 is pointing) positioned between the writing instrument and the pocket clip unit.

In regard to claims 6 and 7, the spacer could either be attached to the pocket clip unit or to the case (see col. 2, line 4 et seq.).

In regard to claims 8 and 9, the pocket clip unit fixedly attached to the case or reversibly attached to the case (see col. 2, line 4 et seq.).

In regard to claim 10, the letter opener writing instrument device further comprises a contoured protrusion (34) affixed to a distal end of the pocket dip unit.

In regard to claims 11 and 16, as best understood for claim 11, the pocket clip unit, further comprises i) a pocket clip arm, the pocket clip arm having a first end, a

second end, and a first surface; ii) means (34) for attaching the pocket clip arm to the writing instrument; iii) the cutting element functionally attached to the first surface of the pocket clip arm proximate the first end of the pocket clip arm, wherein the pocket clip unit is positionable about the writing instrument providing for a letter opener writing instrument.

In regard to claims 14 and 15, the pocket dip arm is either fixedly attached to the means for attachment or is reversibly attached to the case (see col. 2, line 4 et seq.).

In regard to claim 19, the pocket clip cutting element unit further comprises a spacer (where 20 is pointing), the spacer fixedly attached to the first end of the pocket clip arm.

4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Volk et al. (hereinafter Volk).

In regard to claims 1 and 20, Volk discloses a letter opener writing instrument device (see Figs. 1-4) comprising i) a writing instrument (pencil) having a case (the wooden part of the pencil); ii) a pocket clip unit element (elements 4,6 are capable of being a pocket clip unit) affixed to the writing instrument, and iii) a cutting element (5) operatively attached to the device, the cutting element positioned between the writing instrument and the pocket clip unit providing for paper to be cut by the letter opener writing instrument.

In regard to claim 2, the device further comprises a stopper (3 is capable of being a stopper) affixed to the writing instrument thereby limiting accessibility to the cutting element.

In regard to claims 3 and 4, the stopper could either be affixed to the pocket clip unit or the case (see col. 2, line 4 et seq.).

In regard to claim 5, the device further comprises a spacer (where 20 is pointing) positioned between the writing instrument and the pocket clip unit.

In regard to claims 6 and 7, the spacer could either be attached to the pocket clip unit or to the case via member 2.

In regard to claims 8 and 9, the pocket clip unit fixedly attached to the case or reversibly attached to the case via member 2.

In regard to claim 10, the letter opener writing instrument device further comprises a contoured protrusion (2) affixed to a distal end of the pocket dip unit.

In regard to claims 11 and 16, as best understood for claim 11, the pocket clip unit, further comprises i) a pocket clip arm (4,6), the pocket clip arm having a first end, a second end, and a first surface; ii) means (2) for attaching the pocket clip arm to the writing instrument; iii) the cutting element (5) functionally attached to the first surface of the pocket clip arm proximate the first end of the pocket clip arm, wherein the pocket clip unit is positionable about the writing instrument providing for a letter opener writing instrument.

In regard to claim 12, the pocket clip unit further comprises a stopper (3 is capable of being a stopper) wherein the stopper is functionally attached to the clip arm between the cutting element and the second end of the pocket clip arm, therein limiting accessibility to the cutting element.

In regard to claim 13, the pocket clip unit further comprises a stopper (3 is capable of being a stopper) wherein the stopper is functionally attached to the case via member 2 between the cutting element and the second end of said pocket clip arm, therein limiting accessibility to the cutting element.

In regard to claim 14, the pocket dip arm is fixedly attached to the means for attachment via member 2.

In regard to claim 15, the pocket dip arm is reversibly attached to the case via member 2.

In regard to claim 17, the pocket clip unit further comprises a contoured protrusion (2) positioned on the first surface of said pocket clip arm at the second end of pocket dip arm.

In regard to claim 18, the pocket clip unit further comprises a stopper (3 is capable of being a stopper) wherein the stopper is functionally attached to the clip arm between the contour protrusion (2), the stopper thereby defining accessibility to the cutting element.

In regard to claim 19, the pocket clip cutting element unit further comprises a spacer (3), the spacer fixedly attached to the first end of the pocket clip arm.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bedford, Griesbach, and Beadles disclose other combined writing and cutting instrument.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 571-272-4892. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine R. Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tuan Nguyen  
Primary Examiner  
Art Unit 3751  
*5/15/06*

TN